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Amendment under 37 C.F.R. 1.111
U.S. Application No. 10/772,586
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REMARKS

The Office Action of April 6, 2007 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-24 were pending prior to the instant amendment. Claims 7-12 and 19-24 were withdrawn. Claim 2 has been canceled. By this amendment, claims 1, 3-5, and 13-17 are amended. Claims 25-32 have been added. Thus, claims 1, 3-6, 13-18, and 25-32 are presently under consideration for examination.

Claims 1-6 and 13-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogawa (U.S. Patent Publication No. 2003/0132987) in view of Tsutsui (U.S. Patent Publication No. 2001/0027013) and further in view of Mori et al. (JP 2000/169977). Ogawa, Tsutsui, and Mori et al., however, fail to render the claimed invention unpatentable as amended. Each of the claims recites a specific combination of features that distinguishes the invention from the prior art in different ways. For example, each of the amended independent claims 1, 3, 13, 14, and 15 recite a combination that includes, among other things:

ejecting a . . . solution comprising a . . . material using a . . .
solution ejector with moving the . . . solution ejector.

At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 1, 3, 13, 14, and 15.

In order for the Examiner to establish a *prima facie* case of obviousness, the

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Examiner must demonstrate how Ogawa, Tsutsui, and Mori et al., whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. *See* M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner must also show the existence of any reasonable probability of success in modifying Ogawa, the base reference, based on the teachings of Tsutsui and Mori et al., the secondary references, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner must identify any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the apparatus of Ogawa in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner must explain how the obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. *See id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103.

None of the cited prior art references to Ogawa, Tsutsui, and Mori et al. disclose or fairly suggest "ejecting a . . . solution comprising a . . . material using a . . . solution ejector with moving the . . . solution ejector," as recited in the independent claims. In

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accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Ogawa, Tsutsui, nor Mori et al., taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 1, 3, 13, 14, and 15. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1, 3, 13, 14, or 15 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1, 3, 13, 14, or 15.

In addition, each of the dependent claims also recite combinations that are separately patentable.

The Examiner also provisionally rejected claims 1-6 and 13-18 on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims of copending Application Nos. 10/771,421, 10/771,277, and 10/772,419. Applicant respectfully requests the Examiner to hold the double patenting rejection in abeyance until all the prior art rejections are overcome.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent agent at (202) 585-8316.

Respectfully submitted,

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